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In the Supreme Court of the United States

OCTOBER TERM, 1980

WILLARD R. CUSTER AND CUSTER CHANNEL WING CORPORATION, PETITIONERS

v.

UNITED STATES OF AMERICA

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

BRIEF FOR THE UNITED STATES IN OPPOSITION

WADE H. McCREE, JR.
Solicitor General

ALICE DANIEL
Assistant Attorney General

BARBARA L. HERWIG
SUSAN SLEATER
Attorneys

Department of Justice
Washington, D.C. 20530
(202) 633-2217

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QUESTIONS PRESENTED

1. Whether the Court of Claims correctly granted summary judgment in favor of the United States with regard to petitioners' claims of patent infringement.

2. Whether the pendency of an administrative patent infringement claim tolls the statute of limitations for an action claiming infringement of a patent not mentioned in the administrative claim.

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OPINION BELOW

The opinion of the Court of Claims (Pet. App. 1a-19a) is reported at 622 F. 2d 554.

JURISDICTION

The judgment of the Court of Claims was rendered on May 14, 1980. The petition for a writ of certiorari was filed on August 12, 1980. The jurisdiction of this Court is invoked under 28 U.S.C. 1255(1).

STATEMENT

Petitioner Willard Custer holds numerous patents relating to the use of channels on aircraft.[1] In December 1976, he submitted an administrative claim to the Air Force regarding its alleged infringement of patents numbered 3,650,497 and 3,704,842 ("patents '497 and '842"). This administrative claim was subsequently denied, and on April 27, 1978, petitioner filed suit in the United States Court of Claims, asserting infringement of patent number 2,687,262 ("patent '262") as well as patents '497 and '842. Following joinder of petitioner Custer Channel Wing Corporation, the assignee of patent '497, as a plaintiff in January 1979, the United States moved for summary judgment with regard to all three patents. The trial judge recommended that the motion be granted. On review (see Rule 54(b)(3) of the Rules of the Court of Claims), a panel of the Court of Claims adopted the recommended opinion and granted summary judgment in favor of the United States (Pet. App. 1a-4a, 13a).

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[1] A channel is an upwardly open trough or hollow built into an aircraft wing or attached to another part of the aircraft, which, when coupled with the engine or other means of forcing air or gas through the channel, is capable of providing additional lift (Pet. App. 2a-3a). The basic channel structures were patented many years ago and those patents have expired.

The court first concluded (Pet. App. 3a-6a) that petitioner Custer's claims regarding patent '262 were barred by the applicable six-year statute of limitations. See 28 U.S.C. 2501. The court pointed out that this action commenced on April 27, 1978, and that therefore 28 U.S.C. 2501 limited recovery to the period following April 27, 1972. Because patent '262 had expired on August 24, 1971,[2] the court held that petitioner's claims of infringement were barred by Section 2501. See Pet. App. 3a-4a. The court further rejected petitioner's claim that the statute of limitations had been tolled during the pendency of his administrative claim (*id.* at 4a-5a). The court explained that petitioner's administrative claim did not refer either expressly or impliedly to patent '262 but rather unequivocally stated that "[t]he patents infringed are patents numbers 3,650,497 - Claim No. 1, and 3,704,842 - Claim No. 1" (*id.* at 4a).

The court denied petitioner's infringement claim concerning patent '842 on the merits. The court observed that patent '842 specifies channels in the wings over which engine exhaust flows, and a flattened and contoured engine exhaust stack (Pet. App. 7a-9a). The court noted that, in contrast, the A-10 aircraft lacks channels in the wings, and its exhaust stacks "are neither flattened nor contoured" (*id.* at 9a). Nor is the overall configuration of the tail structure of the A-10 at all equivalent to the '842 patent, the court explained, because the patent prosecution history limited the substance of the '842 patent (*id.* at 10a-12a). The court pointed out that the patent "was allowed over the prior art *only* after [petitioner] amended the antecedent claim to specifically

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[2]35 U.S.C. 154 provides that a patent has a term of 17 years from the date of issue. Patent '262 was issued on August 24, 1954 (Pet. 2-3).

limit the location of the channel by providing that the 'open channel is formed *in the wing* of said aircraft and *extends across said wing* from the leading to the trailing edge thereof" (Pet. App. 10a-11a; footnote omitted). Indeed, in obtaining the '842 patent, petitioner "represented to the Patent Office that the stack design was an 'essential' feature of his invention," distinguishing it from prior art (*id.* at 12a). Thus, the court held that the absence of a contoured exhaust stack in the A-10 jet engines was, "by itself, fatal to [petitioner's] infringement claim" (*ibid.*).[3]

The court also found no infringement of the '497 patent (Pet. App. 12a-19a). The court stated that, unlike the specifications of the '497 patent, the A-10 aircraft has no engines mounted on the wings and no channels affixed to the engines capable of selective vertical, angular adjustment like an aileron (*id.* at 14a-15a).[4] The court observed that the prosecution history of the '497 patent demonstrates that the specification of use of channels as ailerons for roll control, which petitioner had emphasized was of "extreme significance," was the sole distinction between the accepted claim and an earlier rejected claim (*id.* at 17a-18a). Accordingly, the court ruled that "the absence of a vertically adjustable open channel *functioning as an aileron* in the A-10 aircraft, as a matter of fact, leads to the conclusion that, as a matter of law, [petitioners'] claim is not infringed" (*id.* at 19a). Consequently, the court held that a dependent '497 patent claim was also necessarily not infringed (*ibid.*).

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[3]In addition, the court stated that even if patent '842 was not so limited, the A-10 did not infringe that patent, because the function of the '842 wing channels was to enhance aircraft stability at low speeds, whereas the A-10 tail channels, as described by petitioner, would decrease stability at low speeds (Pet. App. 11a-12a).

[4]An aileron is " 'a movable hinged section of the wing of an airplane, for banking in turns' " (Pet. App. 17a n.7).

ARGUMENT

The decision of the Court of Claims is correct and does not conflict with any decision of this Court or of the courts of appeals. Moreover, the fact-bound questions presented in the petition for a writ of certiorari raise no issue of general public importance. Further review is therefore unwarranted.

1. Petitioners contend (Pet. 8-16) that the court below erroneously granted summary judgment by relying solely on the affidavits of a government expert. However, the factual conclusions of the Court of Claims that the A-10 aircraft does not meet the literal terms of the '842 and '497 patents were based on the court's visual examination of the aircraft design (Pet. App. 9a and 14a) and petitioners' own admissions (*id.* at 10a and 18a), as well as the government's affidavits. Since petitioners did not argue in the court below that the wing of the A-10 forms a channel or that it is capable of vertical angular movement (see Pet. App. 9a-10a, 15a n.6, 18a), they cannot now be heard to complain because the legal conclusions of the Court of Claims were based on heretofore undisputed facts. See, *e.g.*, *United States* v. *Lovasco*, 431 U.S. 783, 788 n.7 (1977).

In reality, petitioners renew their claim that the structures on the challenged aircraft are equivalent to those described in the patents. But, as the Court of Claims correctly concluded (Pet. App. 10a-11a, 18a), the file wrapper or prosecution history of the patents clarified their scope (see, *e.g.*, *Graham* v. *John Deere Co.*, 383 U.S. 1, 33 (1966); *Teledyne McCormick Selph* v. *United States*, 558 F. 2d 1000, 1005-1006 (Ct. Cl. 1977)) and estopped petitioners from claiming equivalence (see, *e.g.*, *Exhibit Supply Co.* v. *Ace Corp.*, 315 U.S. 126, 135-137 (1942);

Nationwide Chemical Corp. v. *Wright*, 584 F. 2d 714, 718-719 (5th Cir. 1978); *Norwood* v. *Ehrenreich Photo-Optical Industries, Inc.*, 529 F. 2d 3, 9-10 (9th Cir. 1975); *Yosemite Chemical Co.* v. *United States*, 360 F. 2d 948, 953 (Ct. Cl. 1966)). As this Court has explained (*Schriber Co.* v. *Cleveland Trust Co.*, 311 U.S. 211, 220-221 (1940)):

> It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent. * * * The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer. * * * The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest.

The file wrapper discloses that the '842 patent was allowed over prior art only after petitioner Custer amended his claim to limit the channel over which engine exhaust passed to a channel formed in the wing (Pet. App. 10a-11a). Thus, petitioner's claim for equivalence regarding a channel formed by the structure of the A-10 airplane tail is without basis. Moreover, the A-10 aircraft lacks a contoured exhaust stack, which was an essential feature of the '842 patent, distinguishing petitioner's invention from prior art (*id.* at 12a).[5] Similarly, the

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[5]As an alternative basis for denying the '842 patent claim, the court relied on the undisputed evidence in the government affidavit that the equivalent structures claimed by petitioners do not have an equivalent function. See *Graver Tank & Manufacturing Co.* v. *Linde Air*

prosecution history regarding the '497 patent shows that the patent claim was initially rejected and that a vertically adjustable open channel that functions as an aileron to provide roll control was essential to allowance of the patent (Pet. App. 18a). In sum, petitioners' claims failed as a matter of law because the patent prosecution histories estopped them from claiming equivalence. Accordingly, summary judgment in this patent case was appropriate. See, *e.g.*, *Steigleder* v. *Eberhard Faber Pencil Co.*, 176 F. 2d 604 (1st Cir.), cert. denied, 338 U.S. 893 (1949); *Fallon* v. *United States*, 168 F. Supp. 775 (Ct. Cl. 1958).[6]

2. Petitioners further contend (Pet. 16-20) that the Court of Claims erroneously concluded that the administrative claim regarding patents '842 and '497 did not toll the statute of limitations with regard to their belated claim concerning the alleged infringement of patent '262. But the court below properly held that under 35 U.S.C. 286 an administrative claim tolls the statute of limitations only where it is "sufficiently detailed to afford the Government a *realistic* opportunity to consider and settle the claim" as an alternative to costly litigation (Pet. App. 5a). See *Fairchild Engine & Airplane Corp.* v. *United States*, 285 F. 2d 131, 133 (Ct. Cl. 1961). Here,

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Products Co., 339 U.S. 605, 608-609 (1950). Under Rule 101(f) of the Rules of the Court of Claims, an affidavit establishes facts unless opponents "set forth specific facts showing that there is a genuine issue for trial." Thus, the court below properly relied on the government's unopposed affidavit (Pet. App. 11a-12a).

[6]Petitioners also assert (Pet. 14-15) that the motion for summary judgment was unfair because it was filed prior to discovery. Petitioners, however, never requested discovery. See Rules 71(c) and (e) of the Rules of the Court of Claims. To the contrary, petitioner Custer averred in his affidavit that he had "examined the structure of the A-10 aircraft" and was "familiar with said aircraft" (Plaintiff's Response to Defendant's Motion for Summary Judgment Exh. No. 1, para. 2).

however, petitioner's administrative claim focused unequivocally and exclusively on patents '842 and '497, thereby depriving the government of any opportunity to investigate and settle petitioners' claim regarding patent '262. Further review of this case of "first judicial construction" (Pet. 16) is unwarranted.[7]

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

WADE H. MCCREE, JR.
Solicitor General

ALICE DANIEL
Assistant Attorney General

BARBARA L. HERWIG
SUSAN SLEATER
Attorneys

OCTOBER 1980

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[7]Without citing any authority, petitioners suggest (Pet. 19) that the appropriate standard under Section 286 is whether the investigation triggered by the administrative claim encompasses the subsequent suit. In light of the narrow scope of petitioners' administrative claim it is doubtful whether petitioners can satisfy even that test here. In any event, the evident purpose of the tolling provision is to permit settlement of specific claims at the administrative level. *Fairchild Engine & Airplane Corp.* v. *United States*, *supra*.

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